

This listing of claims will replace all prior versions, and listings, of claims in the application.

**Listing of claims:**

Claims 1-4 (cancelled)

Claim 5 (currently amended). A method of inhibiting the loss of solar reflectance over time of an exterior elastomeric coating composition, comprising forming said coating composition comprising an organic binder having a Tg less than -20°C, at least one inorganic additive, and a solid particulate organic polymer having a Tg greater than 70°C, wherein said solid particulate organic polymer having a Tg greater than 70°C is present in an amount such that a volume ratio of said organic binder to said solid particulate organic polymer having a Tg greater than 70°C is in the range of 1.6 : 1 to 95 : 1; applying said coating composition to an exterior surface; and exposing said coating outdoors for a period of greater than 18 months.

Claim 6 (original). The method according to claim 5, wherein said at least one inorganic additive is selected from the group consisting of pigments, extenders and mixtures thereof.

Claim 7 (cancelled)

Claim 8 (previously presented) The method according to claim 5, wherein said volume ratio of said organic binder to said solid particulate organic polymer having a Tg greater than 70°C is in the range of 1.6 : 1 to 9 : 1.3.

# RESPONSE

Claims 5, 6 and 8 are pending in this application. The Examiner rejected claims 5, 6 and 8 under U.S.C. 35 §112 (second paragraph).

Applicants are herein amending claim 5. Applicants respectfully submit that the amendments do not introduce new matter because they are supported by language in the specification on, *inter alia*, page 6, lines 27-29; page 7, lines 4 and 10-11; page 20, lines 24-28; page 21, lines 1-20, and page 22, lines 1-13.

## Rejection under 35 U.S.C. § 112 (Second Paragraph)

The Examiner has rejected claims 5, 6 and 8 under 35 U.S.C. § 112 (second paragraph), asserting that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, because it is not clear what the coating composition is exposed to. The Examiner asserted that claims 5, 6 and 8 would be allowable if amended to overcome the rejection, and suggested that Applicants make such amendments by inserting the words "to solar energy" after "coating" at line 12 of claim 5.

Applicants thank the Examiner for discussing this matter with Applicants during a telephonic conversation on April 14, 2004. As Applicants mentioned during this conversation, Applicants are concerned that the suggested language would be interpreted inconsistently with Applicants' Specification, in that it implies that the coating composition is exposed to solar energy during the entire 18 months of exposure of the coating composition. Applicants respectfully submit that the exterior surface bearing Applicants' coating composition is "exposed" by placing it outdoors for a period greater than 18 months. Since solar energy is a product of the sun, the coating composition is exposed to solar energy only during those times of day that the energy of the sun reaches the coating, which, of course, excludes night-time, particularly overcast days, and any other time the energy of the sun does not reach the coating composition.

Applicants have herein amended the claims to clarify that the coating composition is exposed outdoors for a period greater than 18 months. It is clear to one of ordinary skill in the art that one element of the method of the invention is exposure of the coating composition outdoors for a period of greater than 18 months. Firstly, as noted in the specification and claims, the coating composition is an exterior coating composition. It is well known in the art that exterior coatings are intended for use outdoors. Secondly, as noted in the Webster's Dictionary, the term "exterior" means "*appropriate for outdoor use <an exterior varnish>*". Thirdly, the panels in the exposure examples in Applicants' specification were exposed outdoors. As noted in Applicants' Declaration, attached hereto, the exterior substrates bearing the exterior elastomeric coating composition of the invention were placed outside at Spring House, PA and Philadelphia, PA in the horizontal face-up position during the course of the testing. Thus, while outside, the coating composition was exposed to all of the elements normally occurring outdoors, including, among other things, solar energy.

Further, as noted in the Declaration, it is the belief of the inventor who authored the Declaration that the method of the invention inhibits the loss of solar reflectance over time of an exterior coating composition, regardless of the geographic location of the exterior surface on which the coating composition is deposited, according to the method of the invention, and regardless of the climate, weather conditions, etc. of that location. Thus, the invention's inhibition of the loss of solar reflectance over time is not limited to outdoor exposure of the coating composition of the invention, only at the testing sites. Rather, the invention inhibits the loss of solar reflectance in any geographic location, climate, or weather condition in which the exterior elastomeric coating is applied to an exterior (outdoor) surface, according to the method of the invention.

For the above-mentioned reasons, Applicants respectfully request that the Examiner withdraw the rejection of the claims under 35 U.S.C. § 112 (second paragraph).